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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
VU, NGOC K	

ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/881,815	PONG, TA-CHING	
	Examiner	Art Unit	
	Ngoc K. Vu	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 May 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9 and 11-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9 and 11-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Arguments

1. Applicant's arguments filed 5/25/05 have been fully considered but they are not persuasive.

Applicant argues that Kitsukawa does not teach updating of advertisements inserted into interactive programs, based on user response to program content. Examiner respectfully disagrees.

With respect to claims 1 and 14, it is noted that the limitation "wherein said advertisement is updated based on responses to said program content" is claimed, while the above feature as indicated by applicant is not specifically claimed. In the Kitsukawa reference, the television program 502 is interactive program because the viewers interact with the program via one of the operating modes including an advertisement mode and a stored advertisement mode. The advertisement mode enables the display of advertising information along with television program scene, while the stored advertisement mode causes the received advertising information to be stored and/or the stored advertising information may be recalled and viewed at a time that is different from a display time of a scene in which the corresponding advertised item appears (see col. 7-8, lines 61-13). From this view, the program is an interactive program having operating modes, the operating modes being determined by responses by the viewer to the program, i.e., selecting the advertisement mode or the stored advertisement mode, for displaying the advertising information along with the being broadcast program or displaying the advertising information later. Applicant further asserts "the claimed 'interactive program' included multiple paths chosen by the viewer, the choice of path determining which advertisements are inserted into the program". Again, these features are not claimed.

Applicant also argues that elements 521-529 shown in figure 5 of the Kitsukawa reference are not advertisements. This argument is not persuasive. Each of elements 521-529

in figure 5 indicates the viewers that advertisement content is available. On the other hand, each of elements 521-529 is interpreted as advertisement because it represents a notice designed to attract public or viewers attention. As shown in figure 5, elements 521-529 are displayed in a manner appropriate to the content of displayed program so that the each of elements 521-529 appears to be a part of the content of the program 511-519, 590 and 592 being displayed (each of elements 521-529 indicates advertising information for objects or items 511-519 present in the program scene 502, respectively). For example, advertisement content is available for the chair 511 in which the actor is sitting by selecting the corresponding chair icon 521. Advertising content is available for the hat 513 by selecting the corresponding hat icon 523 (see col. 8, lines 58-67).

Back to claims 1 and 14, the recited limitation "wherein said advertisement is updated based on responses to said program content" is interpreted as providing the advertisement content based on response to the program content from the viewer as taught by Kitsukawa. Particularly, if the viewer selects one of elements 521-529 via interface device 2 (see figure 3), the advertisement content is displayed along with the broadcast of the currently selected television program or may be superimposed over the broadcast of the television program on the screen or the advertisement content is displayed on a portion of the display along with the television program such as picture-in-picture (see col. 7, lines 27-39). As interpreted above, each of elements 521-529 is the part of the program content because each of the elements corresponds to each of objects or items 511-519 in the program scene, respectively. From this view, providing advertisement content is based on responses to program content , i.e., selecting one of the elements 521-529, from the viewer.

Thus, Kitsukawa teaches updating of advertisements based on user response to program content.

In response to applicant's arguments against the references individually, with respect to claims 2-8, 11-13 and 15, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument with respect to claim 6, one skill in the art would have motivated to employ the combination teachings of Kitsukawa, Rosser and Wilf to any events such as musical event for purpose of presenting advertisement to audiences or viewers on a background of a stage.

Therefore, the rejections for claims 1-8 and 11-15 are maintained.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kitsukawa et al. (US 6,282,713 B1).

Regarding claim **1**, Kitsukawa discloses a method of delivering advertising to a user via composite images displayed to the user through a TV 4 (see figure 2), comprising the steps of:

displaying a program 502 (see figure 5); and

inserting, while the program 502 is being displayed, an advertisement (521-529) into a selected portion of the displayed program 502, the advertisement being displayed in a manner appropriate to the content of the displayed program (e.g., elements 521-529 are displayed together with the program 502 as shown in figure 5 - see figure 5 and col. 8, lines 20-36) so that the advertisement appears to be a part of the content of the program 511-519, 590 and 592 being displayed (each of elements 521-529 indicates advertising information for objects or items 511-519 present in the program scene 502, respectively. For example, advertisement content is available for the chair 511 in which the actor is sitting by selecting the corresponding chair icon 521. Advertising content is available for the hat 513 by selecting the corresponding hat icon 523 - see col. 8, lines 58-67),

wherein the program 502 is interactive program having several possible paths (operating modes), the paths (operating modes) being determined by responses by the viewer to the program (i.e., selecting the advertisement mode or the stored advertisement mode, for displaying the advertising information along with the being broadcast program or displaying the advertising information later - see col. 7-8, lines 61-13), and wherein the advertisement is updated based on responses to the program content (each of elements 521-529 is the part of the program content because each of the elements corresponds to each of objects or items 511-519 in the program scene, respectively. From this view, providing advertisement content or the advertisement is updated based on responses to program content, i.e., selecting one of the elements 521-529, from the viewer - see col. 7, lines 27-39; col. 8, line 58 to col. 9, line 11), the responses to the program content being submitted by the user via interface device 2 (see figure 3).

Regarding claim **14**, Kitsukawa discloses a system of delivering advertising to a user via composite images displayed to the user through a TV 4 (see figure 2), comprising the steps of:

means displaying a program 502 (see figure 5); and

means inserting, while the program 502 is being displayed, an advertisement (521-529) into a selected portion of the displayed program 502, the advertisement being displayed in a manner appropriate to the content of the displayed program (e.g., elements 521-529 are displayed together with the program 502 as shown in figure 5 - see figure 5 and col. 8, lines 20-36) so that the advertisement appears to be a part of the content of the program 511-519, 590 and 592 being displayed (each of elements 521-529 indicates advertising information for objects or items 511-519 present in the program scene 502, respectively. For example, advertisement content is available for the chair 511 in which the actor is sitting by selecting the corresponding chair icon 521. Advertising content is available for the hat 513 by selecting the corresponding hat icon 523 - see col. 8, lines 58-67), wherein the program 502 is interactive program having several possible paths (operating modes), the paths (operating modes) being determined by responses by the viewer to the program (i.e., selecting the advertisement mode or the stored advertisement mode, for displaying the advertising information along with the being broadcast program or displaying the advertising information later - see col. 7-8, lines 61-13), and wherein the advertisement is updated based on responses to the program content (each of elements 521-529 is the part of the program content because each of the elements corresponds to each of objects or items 511-519 in the program scene, respectively. From this view, providing advertisement content or the advertisement is updated based on responses to program content, i.e., selecting one of the elements 521-529, from the viewer - see col. 7, lines 27-39; col. 8, line 58 to col. 9, line 11), the responses to the program content being submitted by the user via interface device 2 (see figure 3).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 2 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitsukawa et al. (US 6,282,713 B1) in view of Rosser (WO 98/28906).

Regarding claims **2** and **15**, Kitsukawa does not disclose inserting advertising comprising merging a simulated image into the program. However, Rosser discloses inserting a simulated image such as a still, animated or live video, i.e., AD1 or LOGO B, into a broadcast program (see page 10, lines 7-12; page 13, lines 20-27; pages 13-14, lines 36-11). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kisukawa by inserting a simulated image into the broadcast program as taught by Rosser in order to provide an attractive advertisement to viewer.

6. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitsukawa et al. (US 6,282,713 B1) in view of Kohen (US 6,604,239 B1).

Regarding claim **7**, Kitsukawa does not explicitly disclose that the advertisement is updated in real time. However, Kohen discloses that advertisements, production issues, through which the user can browse to receive real time, or close to real time, updated information on television programs, advertisements (see col. 7-8, lines 66-5). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kitsukawa by providing the updated advertisements in real time as taught by Kohen in order to provide the user the latest information.

Regarding claim **8**, Kitsukawa as modified by Kohen by discloses that the module 32 provides the updated advertisements in real time (see col. 7-8, lines 66-5).

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitsukawa et al. (US 6,282,713 B1) in view of Stautner (US 6,172,677 B1).

Regarding claim **11**, Kitsukawa does not further disclose that the user is given the option of performing on-line or off-line transactions in response to the advertisements. However, Stautner teaches that Pizza Hut advertisement includes telephone number for the user makes an order anytime at anywhere. The user can select icon 40 to place an order on-line. By selecting icon 40, an automated sequence of events performed by the computer would then extract a proper telephone number from the data base, dial the particular number and place the user in a situation where they are in voice contact with the pizza restaurant or alternatively, provide for an automatic selection of the specifications of their desired pizza (see figure 2 and col. 5, lines 25-28; col. 6, lines 50-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kisukawa by providing user option of perform on line by selecting icon 40 or off-line, e.g., by dialing telephone number from user, as taught by Stautner in order to optionally provide user an automatic selection for ordering product/goods or service.

8. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitsukawa et al. (US 6,282,713 B1) in view of Gautier (US 6,618,858 B1).

Regarding claim **12**, Kitsukawa discloses providing electronic links over the Internet to the Web pages of product manufacturers and dealers (see col. 8, lines 53-57). Kitsukawa does not disclose a login process including the steps of determining an identity and location of the user; organizing the identity and location information into a suitable information packet; and

storing the packet in the user's computing device or in computing devices located in the premises of the provider.

However, Gautier teaches that when a viewer logs onto services through an advanced set-top-box (ASTB), the viewer enters a TV name which is used to identify that viewer's account or identity locally on the ASTB. The viewer also enters a PIN and a service he/she wants to access. This information is then used on the local ASTB to retrieve a UID. The UID along with other information is transmitted over the network to the MSO. The MSO uses the UID to retrieve any information it needs to process the viewer's requests *(see figure 3; col. 7, lines 21-36 and col. 7-8, lines 61-4)*.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kitsukawa by including login process to verify the viewer identification for accessing the service as taught by Gautier for system security purposes.

Regarding claim **13**, Kitsukawa discloses that the interface device 2 is computing device, and further comprising the steps of permitting the user to select whether to accept updating of the computing device (e.g., via first mode – see col. 7, lines 65-67 and col. 8, lines 46-47).

9. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitsukawa et al. (US 6,282,713 B1) in view of Rosser (WO 98/28906) and further in view of Wilf et al. (US 6,208,386 B1).

Regarding claim **3**, the combination of Kitsukawa and Rosser does not teach using "blue screen" technology for the step of merging. However, Wilf et al. teach using chroma-key or blue screen technology for electronically replacing a real billboard in a video image display by the replacement billboard. By use of the chroma-key technology there is no requirement to transmit any occlusion data since this can be readily inserted at a receiver and the occlusion inserted in

the normal manner (see col. 3, lines 39-42; col. 4, lines 21-24 and 30-32; col. 5, lines 6-20 and 46-47; col. 14, lines 29-33). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined system of Kitsukawa and Rosser by using the chroma-key or blue screen technology for replacing a portion of the video image, i.e., real billboard in the video image, by a replacement portion, i.e., replacement billboard, at the receiver as taught by Wilf for the advantage of inserting an image into a video image at the receiver with less cost.

Regarding claim **4**, the combination teachings of Kitsukawa, Rosser and Wilf teach that wherein application of the blue screen technology involves adding blue coloring to portions of a real-life environment (Wilf et al. disclose that the billboard to be replaced is blank and is of colour suitable for chroma-key replacement such as blue– see Wilf: col. 5, lines 53-55).

Regarding claim **5**, the combination teachings of Kitsukawa, Rosser and Wilf teach that wherein real-life environment is a sports venue (for example, Rosser shows that a live television broadcast of an event such as a sport event being played on a court 10 – see figure 1), and said blue-painted portions of the real-life environment are areas on which advertisements would normally be displayed, including areas of billboards (for example, Wilf discloses that in an arrangement within a stadium or other sport venue real billboards with normal advertising material will be situated on one side of the stadium to be viewed by a first plurality of cameras and chroma-key billboards will be situated on another or the opposite side to be viewed by a second plurality of cameras – see col. 5, lines 10-15).

Regarding claim **6**, the combination teachings of Kitsukawa, Rosser and Wilf do not teach that a real life environment is a musical event. However, the combination teaching of Rosser and Wilf et al. is used in a real life environment such as a sport event wherein advertisements are displayed on background of the event by using blue screen technology

(see Rosser: figure 1 and Wilf: col. 3, lines 39-42; col. 4, lines 21-24 and 30-32; col. 5, lines 6-20 and 46-47; col. 14, lines 29-33). In view of this, Official Notice is taken that it is well known in the art to use the system as taught by Kitsukawa, Rosser and Wilf for a musical event to present advertisements on the background of the stage. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to present advertisements on a background of a stage in a musical event for the desirable benefit of providing the advertisements to a wider range of audiences.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ngoc K. Vu
Primary Examiner
Art Unit 2611

August 8, 2005